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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,503	03/26/2004	Masayuki Tsuda	9683/177	8171
757 7590 12/19/2007 BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			EXAMINER YOUNG, NICOLE M	
			ART UNIT 2139	PAPER NUMBER
			MAIL DATE 12/19/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/810,503

Applicant(s)

TSUDA ET AL.

Examiner

Nicole M. Young

Art Unit

2139

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2007.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6-19 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 6-19 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

This communication is in response to the amendment of application 10/810,503 received on October 19, 2007. Claims 1-5 have been cancelled. Claims 6-19 are new and currently pending.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 6-15 and 19** are rejected under 35 U.S.C. 102(b) as being anticipated by **Touboul (US 6,092,194)**.

**Claims 1-5** (Canceled)

Regarding **claims 6 and 19**, (New) Touboul teach a terminal device (Figure 1, Internal Network Security System 110) and process comprising:

an execution unit configured to execute an instruction code in accordance with an application program(Figure 2, CPU 205);

a first memory (Figure 2, RAM 235) configured to store data and a protection flag, the protection flag indicative of whether the corresponding data requires security protection (column 7 lines 30-45 "thereby flagging a potential imminent security threat);

a second memory configured to store restriction information for specifying a restricted code, the restricted code being an instruction code whose execution is restricted, the restricted code being one of instruction codes that can be executed by the execution unit, the restricted code including an instruction code causing the execution unit to access target data stored in the first memory with a protection flag indicative of requiring security protection (Figure 2, Data Storage Device 230 and Figure 3 which is an extension of Figure 2, Security Database 240 within Data Storage Device 230; Further explanation is found in column 3 lines 42-66 and column 4 lines 1-12. These disclose a second storage device that has a restriction database.);

a determination unit configured to determine, when the application program is executed, whether a target code is included in the restriction code, the target code being an instruction code in the application program to be executed by the execution unit (Figure 2, Data Storage Device 230 and Figure 3 which is an extension of Figure 2, Security Database 240 within Data Storage Device 230; Further explanation is found in column 3 lines 42-66 and column 4 lines 1-12. These disclose a second storage device that determines if the Downloadable is suspicious); and

a prevention unit configured to prevent the execution unit from executing the target code if the determination unit determines that the target code is included in the restriction code in order to prevent the target code from accessing at least a part of the data whose protection flag is indicative of receiving security protection (Column 3 lines 9-22, discloses preventing suspicious Downloadables from being executed).

Regarding **claim 7**, (New) Touboul teaches the terminal device according to Claim 6, wherein

the application program includes an identifier indicative of whether a provider of the application program is trusted (column 7 lines 30-45 "thereby flagging a potential imminent security threat),

the determination unit is configured to determine whether the target code is included in the restriction code when the identifier included in the application program is indicative that the provider of the application program is not trusted (Figure 2, Data Storage Device 230 and Figure 3 which is an extension of Figure 2, Security Database 240 within Data Storage Device 230; Further explanation is found in column 3 lines 42-66 and column 4 lines 1-12. These disclose a second storage device that determines if the Downloadable is suspicious).

Regarding **claim 8**, (New) Touboul teaches the terminal device according to Claim 6,

further comprising a transmitter for transmitting at least part of the data stored in the first memory (Figure 2 shows various communication transmitters),

wherein the restricted code includes an instruction code causing the transmitter to transmit at least some of the data in the first memory (Figure 2, Data Storage Device 230 and Figure 3 which is an extension of Figure 2, Security Database 240 within Data Storage Device 230; Further explanation is found in column 3 lines 42-66 and column 4 lines 1-12. These disclose a second storage device that has a restriction database).

Regarding claim 9, (New) Touboul teaches the terminal device according to Claim 8, wherein the determination unit determines whether the application program causes the transmitter to transmit the at least some of the data to a content provider that provided the application program (Figure 2, Data Storage Device 230 and Figure 3 which is an extension of Figure 2, Security Database 240 within Data Storage Device 230; Further explanation is found in column 3 lines 42-66 and column 4 lines 1-12. These disclose a second storage device that determines if the Downloadable is suspicious).

Regarding **claim 10**, (New) Touboul teaches the terminal device according to Claim 6, further comprising a communication unit configured to communicate via a communications network,

wherein the determination unit is configured to determine whether the target code is included in the restriction code when the application program subject to execution is acquired via the communications network (Figure 2, Data Storage Device 230 and Figure 3 which is an extension of Figure 2, Security Database 240 within Data Storage Device 230; Further explanation is found in column 3 lines 42-66 and column 4 lines 1-

12. These disclose a second storage device that determines if the Downloadable is suspicious).

Regarding **claim 11**, (New) Touboul teaches the terminal device according to Claim 6, further comprising

a display device configured to display an image (Figure 2 I/O Interfaces 215), wherein instruction codes other than the restricted code include an instruction code to cause the display device to display information on the basis of the data stored in the first memory with a protection flag indicative of requiring security protection (column 7 lines 30-45 "thereby flagging a potential imminent security threat).

Regarding **claim 12**, (New) Touboul teaches the terminal device according to Claim 6, wherein the execution unit is configured to execute an exception process when the prevention unit prevents the execution unit to execute the target code (Column 3 lines 9-22, discloses preventing suspicious Downloadables from being executed).

Regarding **claim 13**, (New) Touboul teaches the terminal device according to Claim 12, wherein the exception process comprises notifying a user of the terminal device that the target code is attempting to execute a restricted operation (Figure 5 user notification engine 515).

Regarding **claim 14**, (New) Touboul teaches the terminal device according to Claim 12, wherein the exception process is executed prior to execution of the application program (Figure 2, Data Storage Device 230 and Figure 3 which is an extension of Figure 2, Security Database 240 within Data Storage Device 230; Further explanation is found in column 3 lines 42-66 and column 4 lines 1-12. These disclose a second storage device that determines if the Downloadable is suspicious).

Regarding **claim 15**, (New) Touboul teaches the terminal device according to Claim 12, wherein the exception process is executed after execution of the application program (Figure 2, Data Storage Device 230 and Figure 3 which is an extension of Figure 2, Security Database 240 within Data Storage Device 230; Further explanation is found in column 3 lines 42-66 and column 4 lines 1-12. These disclose a second storage device that determines if the Downloadable is suspicious).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Touboul (US 6,092,194)** as applied to claims 1-15 and 19 above, and further in view of **Ginter et al. (US 7,124,302)** herein referred to as Ginter.

Regarding **claim 16**, (New) Touboul teaches the terminal device according to Claim 6.

Touboul does not teach wherein the data that requires security protection comprises telephone numbers stored in the first memory.

Ginter teaches wherein the data that requires security protection comprises telephone numbers stored in the first memory in column 58 lines 28-49 "electronic telephone directory").

It would have been obvious at the time the invention was made to use the system set up by Touboul to protect the telephone numbers of Ginter, since Ginter states that these directories of numbers must be protected so authorized users can be charged when accessing them.

Regarding **claim 17**, Touboul teaches the terminal device according to Claim 6.

Touboul does not teach wherein the data that requires security protection comprises a call history table stored in the first memory.

Ginter teaches wherein the data that requires security protection comprises a call history table stored in the first memory.

It would have been obvious at the time the invention was made to use the system set up by Touboul to protect the telephone numbers of Ginter, since Ginter states that

these directories of numbers must be protected so authorized users can be charged when accessing them.

Regarding **claim 18**, (New) Touboul teaches the terminal device according to Claim 6.

Touboul does not teach wherein the terminal device comprises a mobile terminal.

Ginter teach wherein the terminal device comprises a mobile terminal in column 252 under the heading Portable Electronic Appliance.

It would have been obvious at the time the invention was made to use the system set up by Touboul to protect the mobile devices of Ginter, since in Ginter column 253 lines 38-44 states that the user manages their accounts with the mobile device.

### ***Response to Arguments***

Applicant's arguments with respect to claims 6-19 have been considered but are moot in view of the new ground(s) of rejection.

The Applicant argues that Touboul teaches scanning the Downloadables before they are executed for risk which does not disclose preventing "execution when the application program is executed". The Examiner states MPEP 2144.04 which discusses, if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court. Examples directed to various common practices which the court has held normally require only ordinary skill in the art and hence are considered routine expedients are

discussed below. If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection.

#### C. Changes in Sequence of Adding Ingredients

Ex parte Rubin, 128 USPQ 440 (Bd. App. 1959) (Prior art reference disclosing a process of making a laminated sheet wherein a base sheet is first coated with a metallic film and thereafter impregnated with a thermosetting material was held to render prima facie obvious claims directed to a process of making a laminated sheet by reversing the order of the prior art process steps.). See also In re Burhans, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results); In re Gibson, 39 F.2d 975, 5 USPQ 230 (CCPA 1930) (Selection of any order of mixing ingredients is prima facie obvious.).

The order of the steps of determining the application is a risk is not a critical limitation and does not provide new or unexpected results.

#### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. **Ginter et al. (US 7,124,302)** was cited on the prior non-final rejection so no new 892 is attached.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicole M. Young whose telephone number is 571-270-1382. The examiner can normally be reached on Monday through Friday, alt Fri off, 8:00am-5:30pm.

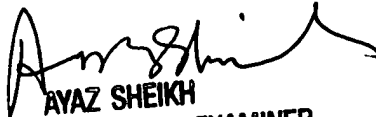
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NMY  
12/14/2007

  
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